

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1 to 3 are pending in the present Application. Claims 4-8 were previously canceled by amendment without prejudice. In the present response Applicants have amended Claim 1 and added new Claims 9 to 11. New Claims 9 to 11 are derived from original Claims 1 to 3 and further clarify Applicant's invention. Support for the term "somatic pain" in amended Claim 1 can be found in the specification as filed at page 17, line 15, following "Example". Support for new Claims 9 to 11 can be found in the specification as filed at, for example, page 4, lines 10 to 16, page 6, line 10 and in originally-filed Claims 1 to 3 and 7.

II. Claim rejections

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jain et al. (Brain Research 909, 2001, 170-178) ("Jain") in view of Cardenas et al. (Arch Phys Med Rehabil Vol. 83, Dec. 2002) ("Cardenas").

Claims 2-3 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jain et al. (Brain Research 909, 2001, 170-178) ("Jain") in view of Cardenas et al. (Arch Phys Med Rehabil Vol. 83, Dec. 2002) ("Cardenas"), and further in view of Maw et al. (U.S. Patent No. 6,856,439) ("Maw").

III. Remarks as to Obviousness under 35 U.S.C. § 103(a)

A.) Jain in view of Cardenas

It is well accepted (e.g., MPEP §2142) that in order to establish a prima facie case of obviousness the Office must show:

- (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
- (2) there is a reasonable expectation of success if the modification or combination is carried out, and

(3) the reference, or references when combined, teach or suggest all the claim limitations.

Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. Jain and Cardenas, either alone or together, do not teach or suggest the claimed invention.

Independent Claim 1, currently amended, now specifies:

- a) A method for alleviating somatic pain
- b) in a patient suffering from spinal cord injury,
- c) said method comprising the step of administering to the patient an effective amount of sildenafil or a pharmaceutically acceptable salt thereof
- d) sufficient to alleviate the somatic pain.

Jain and Cardenas neither disclose, suggest nor render obvious all the material elements of Applicants' invention, much less the combination of elements. Jain fails to disclose or suggest the use of sildenafil to alleviate somatic pain arising from spinal cord injury or any other type of injury or treatment. Cardenas fails to disclose or suggest the use of sildenafil or any other form of therapy to alleviate somatic pain arising from spinal cord injury.

B) Jain in view of Cardenas, further in view of Maw

The inclusion of Maw does not supplement the deficiencies of Jain and Cardenas discussed above. One of ordinary skill in the art would not predict that sildenafil would be effective in alleviating somatic pain in a patient suffering from spinal cord injury based upon any of these references, alone or in combination.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of present Claims 1 to 3 over Jain, Cardenas and Maw. Accordingly, the aforementioned §103 objection should not be maintained against Claims 1 to 3.

IV. Conclusion

For all of the above reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested. Favorable consideration and early allowance of pending Claims 1 to 3 and 9 to 11 is requested.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, the Examiner is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



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